

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

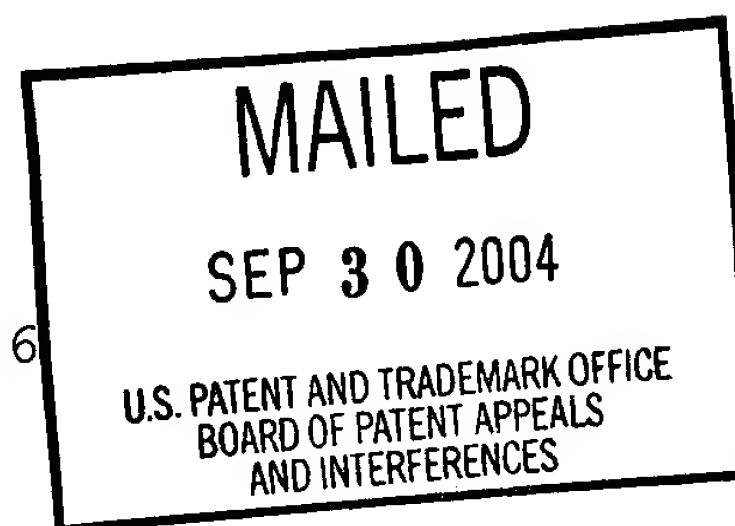
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID D. BOHN

Appeal No. 2004-2142
Application No. 09/220,736

ON BRIEF



Before HAIRSTON, KRASS and SAADAT, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-17.

The invention pertains to hand-held optical scanners. In particular, the invention seeks to remedy the problem of non-uniformly illuminating features on the object being scanned by the use of an occluding element positioned between the lens and the illuminated area on the object so that the occluding element

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blocks a predetermined amount of light from a brightly illuminated region in the illuminated area but does not substantially block light from a less brightly illuminated region in the illuminated area.

Representative independent claim 1 is reproduced as follows:

1. An optical system for forming an image of at least a portion of an illuminated area on an object, the illuminated area being characterized by at least one brightly illuminated region and at least one less brightly illuminated region, comprising:

a lens positioned a spaced distance from the illuminated area on the object, said lens having an image side focal plane;

an aperture stop positioned so that it is substantially coplanar with the image side focal plane of said lens; and

an occluding element positioned between said lens and the illuminated area on the object so that said occluding element blocks a predetermined amount of light from the brightly illuminated region but does not substantially block light from the less brightly illuminated region.

The examiner relies on the following reference:

Thomson	3,825,747	Jul. 23, 1974
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Claims 1-3 and 7-9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Thomson.

Claims 4-6 and 10-17 stand rejected under 35 U.S.C. § 103 as unpatentable over Thomson.

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Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The examiner sets forth, at page 4 of the answer, the correspondence of the claimed elements to elements disclosed in the Thomson reference. The examiner specifically equates the claimed "object" with item 10 in Thomson. It is clear from Thomson, that element 10 depicted therein is a light source and is most definitely not the object to be scanned. Accordingly, the examiner's whole premise about how the elements of Thomson are alleged to meet the instant claim language is flawed.

Since the examiner has clearly not established a prima facie case of anticipation, we will not sustain the rejection of claims 1-3 and 7-9 under 35 U.S.C. § 102(b).

Moreover, we also will not sustain the rejection of claims 4-6 and 10-17 under 35 U.S.C. § 103 because we find no reason

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that it would have been obvious to place the claimed elements in the specific arrangement recited in the instant claims, i.e., with a lens positioned a spaced distance from an illuminated area on the object, an aperture stop positioned so that it is substantially co-planar with the image side focal plane of the lens, and an occluding element positioned between the lens and the illuminated area on the object so that the occluding element blocks a predetermined amount of light from the brightly illuminated region but does not substantially block light from the less brightly illuminated region.

Accordingly, the examiner's decision is reversed.


KENNETH W. HAIRSTON
Administrative Patent Judge


ERROL A. KRASS
Administrative Patent Judge

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MAHSHID D. SAADAT
Administrative Patent Judge

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